

REMARKS

Applicants have carefully reviewed the Final Office Action dated January 19, 2005, regarding the above-referenced patent application. Claims 1-57 are pending in the application, wherein claims 1-37, 44 and 49-57 are withdrawn from consideration as being drawn to a nonelected species. The Examiner has rejected claims 38-43 and 45-48. Favorable consideration of the following remarks prepared in response to the basis for rejection in the Final Office Action is respectfully requested.

Claims 38-43 and 45-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Khosravi (U.S. Patent No. 6,129,739) in view of Palmer et al. (U.S. Patent No. 6,660,021). Applicants respectfully traverse this rejection, asserting a *prima facie* case of obviousness has not been established with the combination of references.

Applicants assert there is no motivation to combine the teachings of the prior art references cited by the Examiner, a fundamental element necessary in establishing a *prima facie* case of obviousness. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." M.P.E.P. §2142, quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The cited references neither expressly nor impliedly provide motivation for their combination. There are three possible sources of motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. See M.P.E.P. §2143.01. None of these sources of motivation is present. In establishing a *prima facie* case, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." See M.P.E.P. §2141.02, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Applicants assert Palmer et al. clearly teaches away from that disclosed in Khosravi, and thus there is no motivation to combine the references. In light of the teachings of the references, one of ordinary skill in the art would not be inclined to modify Palmer in view of Khosravi.

Khosravi teaches a vascular device comprising one or more support hoops and a blood permeable sac affixed to the support hoop or hoops to form a mouth of the blood permeable sac. See Khosravi, Abstract. The teachings of Khosravi attempt to improve known hoop structures by providing one or more articulation regions in an attempt to solve the problem of the formation of kinks in the hoop. See Khosravi, column 4, line 40 through column 5, line 31.

On the other hand, Palmer teaches an intravascular snare device for trapping foreign material from blood vessels. The snare device in Palmer includes a structure having a monolithic framework of thin struts. See Palmer, column 4, lines 33-35. Palmer expressly states several disadvantages of prior emboli removal devices such as those taught in Khosravi. Palmer states, "such devices have been found to have structures which are either highly complex such as with multiple components or highly convoluted geometry or lacking sufficient or effective expansion and retraction capabilities." Column 3, lines 43-51. Palmer further states loop snares and wire basket snares, such as described in Khosravi, "have limited effectiveness, due in part to the lack of encapsulation." Column 4, lines 1-2.

In short, Palmer discredits the device taught in Khosravi and attempts to solve a distinctly different problem than that of Khosravi. After reading Palmer, one of skill in the art would not be motivated to look to the teachings of Khosravi in an attempt to modify the device taught in Palmer. Attempting to modify Palmer in view of Khosravi would contradict the express teachings of Palmer. Thus, none of the three possible sources of motivation to combine the references is present, either expressly or impliedly.

Likewise, the teachings of the current invention teach away from what is disclosed in Khosravi. The current invention expressly states:

The efficacy of the embolectomy device to dislodge the blood clot from the vessel wall depends in part on the mechanical strength of the collector element. In an embolectomy device employing basket-type filters, for example, the proximal section of the device must have sufficient strength to support the filter basket in an expanded position while the blood clot is dislodged from the vessel wall. An insufficient amount of strength at the proximal section of the device may, in certain circumstances, cause the filter basket to deflect away from the vessel wall

at the site of the blood clot. As a result, the ability of the embolectomy device to dislodge and subsequently capture the clot may be compromised.

Page 2, lines 12-20.

In view of the foregoing, Applicants note the Examiner must "consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant." M.P.E.P. §2142. Therefore, it is clear from the teachings of the current application that the support hoop taught in Khosravi may provide insufficient mechanical strength and deflect away from the vessel wall during an embolectomy procedure. The articulation region taught in Khosravi would only enhance this problem addressed in the current application. The articulation region of the support hoop includes a more flexible region having a reduced diameter. See Khosravi, column 6, lines 3-11. Thus, engagement of the hoop along a vessel wall would cause the articulation region to deflect and the hoop to fold in half and collapse. Therefore, one of ordinary skill in the art would not be motivated by Khosravi in an attempt to reach the currently claimed invention.

Applicants respectfully assert the individual teachings of the cited references, as well as the teachings of the current invention, clearly indicate a lack of motivation to combine the cited references. Therefore, Applicants assert the above discussion of the teachings of Palmer and Khosravi clearly rebuts the Examiner's attempt of establishing a *prima facie* case of obviousness. There is no suggestion as to the desirability to combine the teachings of the prior art found in the references. Favorable consideration of the evidence supporting withdrawal of the obviousness rejection is requested, noting "[a] determination under 35 U.S.C. §103 should rest on all the evidence and should not be influenced by any earlier conclusion." M.P.E.P. 2144.08, citing Piasecki, 745 F.2d at 1472-73, 223 USPQ at 788; *In re Eli Lilly & Co.*, 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990).

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

Date:

March 21, 2005 *MMT* *[Signature]*

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